UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,410	12/29/2000	Mark Owen Homewood	00-BN-056 (STMI01-00056)	7823

30425 7590 09/27/2004	EXAMINER
STMICROELECTRONICS, INC.	MEONSKE, TONIA L

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ART UNIT	PAPER NUMBER
2183	

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/751,410	HOMEWOOD ET AL.
	Examiner	Art Unit
	Tonia L Meonske	2183

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
   Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _28 June 2004_.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-20_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-20_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 1-04)   Office Action Summary   Part of Paper No./Mail Date 092104

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless-
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2.   Claims 1-13 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Emma et

al., US Patent 4,991,080.

3.   The rejections are respectfully maintained and incorporated by reference as set forth in

the last office action mailed on March 24, 2004.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emma et

al., US Patent 4,991,080, in view of Boettner et al., US Patent 4,777,589.

6.   The rejections are respectfully maintained and incorporated by reference as set forth in

the last office action mailed on March 24, 2004.

Response to Arguments

7.   Applicant's arguments filed June 28, 2004 have been fully considered but they are not

persuasive.

8.   On page 11, Applicant argues in essence:

> *"The Applicants respectfully note that Claims 1 and 8 distinguish between computation
> of a "branch address" and computation of a "branch condition." A data processor uses
> the "branch condition" to select a branch address." (Application, Page 21, Lines 1-3)."*

However, claimed subject matter, not the specification, is the measure of invention.

Limitations in the specification cannot be read into the claims for the purpose of avoiding

the prior art. *In re Self*, 213 USPQ 1,5 (CCPA 1982); *In re Priest*, 199 USPQ 11,15

(CCPA 1978). In this case applicant has not distinguished between a branch address and

a branch condition in the claims. Therefore, this argument is moot.

9.   On page 11, Applicant argues in essence:

> *"Claims 1 and 8 recite that a branching cluster and a non-branching cluster are "each
> capable of computing branch conditions" and that the branching cluster is capable of
> performing "branch address computations for both of the clusters.*
> *Based on these recitations in Claims 1 and 8, the Office Action must show that all of the
> cited elements of Emma (elements 201-701) are capable of "computing branch
> conditions" and that elements 301 and 501 of Emma are capable of performing "branch
> address computations" for all of the elements 201-701. The Office Action fails to make
> this showing."*

However, according to the claims, 1) the branching cluster must be capable of producing

a branching condition, 2) the non-branching cluster must be capable of producing a

branching condition, and 3) the branching cluster must be operable to perform branch

address computations. Emma has in fact taught 1) the branching cluster is capable of

producing a branching condition (Figure 3, elements 301 and 501, column 23, lines 35-

47, Element 301 produces a branch target address), 2) the non-branching cluster is

capable of producing a branching condition (Figure 3, elements 701, 201, 401, 601,

Element 701 sends branching conditions through element 581, column 23, line 23 –

column 24, line 17), and 3) the branching cluster is operable to perform branch address

computations (Figure 3, elements 301 and 501, column 23, lines 35-47, Element 301

computes a branch target address). Therefore this argument is moot.

10.   On pages 12, 14 and 15, Applicant argues in essence:

> *"Nothing in the four cited portions of Emma describes how both a "branching cluster"*
> *and a "non-branching cluster" may compute "branch conditions" as recited in Claims 1*
> *and 8. Instead, all of the cited portions refer to processing "branch addresses." In fact,*
> *the four cited portions of Emma contain absolutely no mention of computing any type of*
> *"branch conditions." As a result, the Office Action fails to establish that the cited*
> *elements 201-701 if Emma anticipate "branching" and "non-branching" clusters each*
> *capable of computing "branch conditions" as recited in Claims 1 and 8."*

However, a branch address is a branch condition. According to Merriam-Webster's

online dictionary, the word "condition" is defined as "something essential to the

appearance or occurrence of something else." In order for the branch instruction to

actually branch, the branch address must be known. The branch address is essential for

the instruction to branch. So the branch address is a branch condition and Emma has in

fact taught computing branch addresses, or branch conditions. Therefore, this argument

is moot.

11.   On page 13, Applicant argues in essence:

> *"Nothing in the two cited portions of Emma describes how a "branching cluster" is*
> *capable of performing "branch address computations" for both the branching cluster*
> *and a "non-branching cluster" as recited in Claims 1 and 8. Instead, the cited portions*
> *of Emma merely recite that branch addresses may be retrieved from a table. As a result,*
> *the Office Action fails to establish that the elements 301 and 501 of Emma anticipate a*
> *"branching cluster" capable of performing "branch address computations" for both*
> *"branching" and "non-branching" clusters as recited in Claims 1 and 8. "*

Applicant is correct in that branch addresses are retrieved from a table Emma et al.

Retrieving a branch address from a table is a branch addresses computation. According

to Merriam-Webster's online dictionary, the word "compute" is defined as "to determine

or calculate by means of a computer." When Emma et al. performs a table look-up for a

branch address, the branch address is determined by means of a computer. The branch

address is computed in Emma et al. Therefore this argument is moot.

Conclusion

12.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

13.   A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing
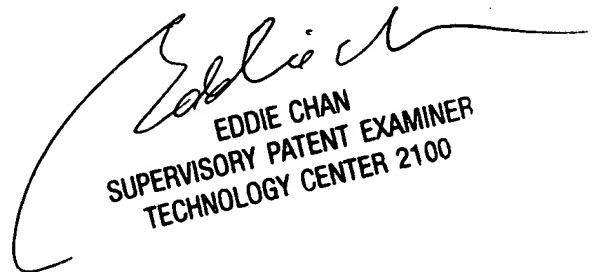
date of this final action.

14.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Tonia L Meonske whose telephone number is (703) 305-3993.

The examiner can normally be reached on Monday-Friday, 8-4:30.

15.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Eddie P Chan can be reached on (703) 305-9712. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

16.   Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tlm

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